

III. REMARKS/ARGUMENTS

A. Status of the Application

Claims 1, 9, 11, 12, 29 and 31 are amended. Claims 32 – 95 are cancelled. Claims 96 – 126 are added. Thus, claims 1 – 31 and 96 – 126 are now pending. Reconsideration of this application in light of the following remarks is respectfully requested.

B. Restriction Requirement

Restriction to one of the following inventions was required under 35 USC § 121:

- I. Claims 1 – 31, drawn to a method of cementing a subterranean formation.
- II. Claims 32 – 95, drawn to a cement composition and methods of preparing.

Applicants affirm the election of the invention of Group I, claims 1 – 31. Claims 32 – 95 are canceled herein without prejudice or disclaimer, as Applicants intend to pursue the subject matter of these claims in a related application.

C. Rejection of Claims 11 – 13 under 35 U.S.C. § 112

Claims 11 – 13 stand rejected under 35 U.S.C. § 112, second paragraph, for reciting ratios of first and second fluid loss additives that are different from the ratio recited in claim 1.

Claim 1 has been amended herein to recite that the first fluid loss additive is present in an amount that is less than the amount of the second fluid loss additive. Each of claims 11 – 13 depends from claim 1, and each recites specific amounts of the first fluid loss additive that are less than the amounts of the second fluid loss additive.

Claims 11 and 12 have also been amended to correct typographical errors with respect to the amounts of fluid loss additives recited therein. Support for the amendments to claims 11 and 12 can be found in the specification at page 3, Table 1A; and page 4, paragraph [0029].

In view of the foregoing, Applicants respectfully request that the rejection of claims 11 – 13 under 35 USC § 112, second paragraph be withdrawn.

D. Double Patenting Rejection of Claims 1 – 17 and 20 – 31

Claims 1 – 17 and 20 – 31 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 45 of copending

Application No. 10/608,748 to Morgan et al. ("Morgan et al."). This rejection is respectfully traversed.

In the subject application, each of claims 2 – 17 and 20 – 31 depends directly or indirectly from claim 1, and therefore each includes all of the limitations of claim 1. Claim 1 is drawn to a method of cementing in a subterranean zone comprising forming a cement composition by mixing a cement mix comprising a base blend and proportioned fluid loss additives with a mixing fluid, placing the cement composition into the subterranean zone, and allowing the cement composition to set therein. The base blend includes zeolite in an amount of at least 20 weight percent and at least one cementitious material. The proportioned fluid loss additives include a first fluid loss additive having a first molecular weight and a second fluid loss additive having a second molecular weight that is less than the first molecular weight. The first fluid loss additive is present in an amount that is less than the amount of the second fluid loss additive.

In Morgan et al., each of claims 2 – 38 depends directly or indirectly from claim 1, and therefore each includes all of the limitations of claim 1. Each of claims 40 – 45 depends directly or indirectly from claim 39 and therefore each includes all of the limitations of claim 39. Each of claims 1 and 39 recite a method of cementing in a subterranean formation that includes placing a cement composition comprising a hydraulic cement, water and a fluid loss control additive in the subterranean formation and permitting it to set. Claim 1 requires that the fluid loss control additive include an acrylamide copolymer derivative and a hydratable polymer. Claim 39 requires that the fluid loss control additive include an acrylamide copolymer derivative and a dispersant.

Applicants note that MPEP § 804 advises that "the analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 USC § 103(a) rejection." MPEP § 804 at p. 800-21. MPEP § 2142 provides that a rejection under 35 USC § 103(a) must satisfy three basic criteria: (1) the prior art reference must teach or suggest all the claim limitations; (2) there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference; and (3) there must be a reasonable expectation of success. In the present case, claims 1 – 45 of Morgan fail to meet any of the criteria set forth in MPEP § 2142 with respect to claims 1 – 17 and 20 – 31.

For example, claims 1 – 45 of Morgan et al. do not teach or suggest cementing with a composition that includes zeolite in an amount of at least 20 weight percent. Claims 1 – 45 of Morgan et al. also fail to teach cementing with a composition that includes a first fluid loss additive having a first molecular weight and a second fluid loss additive having a second molecular weight that is less than the first molecular weight, where the first fluid loss additive is present in an amount that is less than the amount of the second fluid loss additive. Accordingly, Morgan et al. fails to teach or suggest all of the limitations of claims 1 – 17 and 20 – 31.

Further, there is no motivation or suggestion to modify the methods described by claims 1 – 45 of Morgan et al. so as to include cementing with a composition that contains zeolite in an amount of at least 20 weight percent, and also contains fluid loss additives with different molecular weights, where the fluid loss additive with the greater molecular weight is present in an amount that is less than the amount of the fluid loss additive with the lesser molecular weight.

Finally, in view of Morgan et al.'s failure to teach or suggest all of the limitations of claims 1 – 17 and 20 – 31, and failure to motivate or suggest modifications related to the subject matter of claims 1 – 17 and 20 – 31, Applicants further submit that there could be no reasonable expectation of success for achieving the subject matter of claims 1 – 17 and 20 – 31.

In view of the foregoing, Applicants submit that Morgan et al. fails the analysis required of a rejection under 35 U.S.C. § 103(a) and therefore Morgan et al. also fails the analysis required under MPEP § 804 to sustain the present double patenting rejection. Accordingly, Applicants respectfully request that the provisional rejection of claims 1 – 17 and 20 – 31 for obviousness-type double patenting over Morgan et al. be withdrawn.

E. Rejection of Claims 1 – 3, 6 – 14 and 20 – 31 under 35 U.S.C. § 103(a)

Claims 1 – 3, 6 – 14 and 20 – 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2004/0262000 to Morgan et al., which is the publication corresponding to Application No. 10/608,748 discussed above. This rejection is respectfully traversed.

Applicants submit that Morgan et al. is not available as prior art against the subject application pursuant to 35 USC § 103(c)(1). 35 USC § 103(c)(1) states that:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this

section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Morgan et al. satisfies the criteria under 35 USC §103(c)(1), and therefore cannot preclude patentability under 35 USC §103(a) of the subject matter of claims 1 – 3, 6 – 14 and 20 – 31.

1. Morgan et al. is Subject Matter Developed By Another Person.

The inventive entity named in Morgan et al. consists of Rickey L. Morgan, William J. Caveny and Ronney R. Koch, none of which are listed as inventors in the subject application, and therefore none of which are inventors of the subject matter of claims 1 – 3, 6 – 14 and 20 – 31 (i.e., the “Claimed Invention”). Accordingly, Morgan et al. constitutes subject matter developed by “another person” with respect to the Claimed Invention.

2. Morgan et al. would Qualify as Prior Art only under 35 USC § 102(e).

The respective filing and publication dates of Morgan et al. and the subject application are as follows:

Date	Activity
June 27, 2003	Morgan et al. filed
April 1, 2004	Subject Application filed
December 9, 2004	Subject Application published
December 30, 2004	Morgan et al. published

Morgan et al. was not published before the filing date of the subject application, and therefore is not prior art under 35 USC §102(a) or §102(b). Further, none of 35 USC §§ 102(c), (d), (f) or (g) are applicable to the subject application. The only remaining category of prior art is defined by 35 USC § 102(e).

35 USC § 102(e)(1) defines a category of prior art that includes applications for patent, published under 35 USC §122(b), by another, filed in the United States before the invention by the applicant for patent.

As discussed above, Morgan et al. was published, is a patent application “by another”, and was filed in the United States before the constructive invention date by the applicant for patent, namely, the date the subject application was filed.

In view of the foregoing, Applicants submit that Morgan et al. would qualify as prior art against the subject application only under 35 USC § 102(e).

3. Morgan et al. and the Claimed Invention Were, At the Time the Claimed Invention was Made, Owned by the Same Person, or Subject to an Obligation to Assign to the Same Person.

Enclosed is a signed statement from Mr. Craig Roddy of Halliburton Energy Services, Inc., which states that Morgan et al. and the Claimed Invention were, at the time the Claimed Invention was made, owned by the same person or subject to an obligation of assignment to the same person, namely, to Halliburton Energy Services, Inc.

In view of the foregoing, Applicants submit that all of the requirements of 35 USC §103(c)(1) have been met, and therefore Morgan et al. is not available as prior art against the subject application pursuant to 35 USC §103(c)(1). Accordingly, Applicants respectfully request that the rejection of claims 1 – 3, 6 – 14 and 20 – 31 under 35 USC § 103(a) over Morgan et al. be withdrawn.

F. Rejection of Claims 15 and 17 under 35 USC § 103(a)

Claims 15 and 17 stand rejected under 35 USC § 103(a) as being unpatentable over Morgan et al. in view of U.S. Patent No. 6,964,302 to Luke et al. (“Luke et al.”). This rejection is respectfully traversed.

As discussed above with respect to the rejection of claims 1 – 3, 6 – 14 and 20 – 31 under 35 USC §103(a) over Morgan et al., Morgan et al. is not available as prior art against the subject application pursuant to 35 USC §103(c)(1). Thus, Luke et al. must stand alone in the current rejection.

Applicants submit, however, that Luke et al. cannot sustain a rejection of claims 15 and 17 under 35 USC § 103(a) for at least the following reasons: (1) the subject application claims priority from Luke et al., and therefore subject matter that is claimed in the subject application, which is fully supported under 35 USC§ 112 by Luke et al., is entitled to the benefit of the filing date of Luke et al; and (2) Luke et al. is not available as prior art against the subject application pursuant to 35 USC §103(c)(1).

With the exception of the proportioned fluid loss additives recited in claims 15 and 17 the subject matter described in claims 15 and 17, (and in claim 1 from which each depends), is fully

supported under 35 USC § 112 by Luke et al, and therefore is entitled to the filing date of Luke et al. Accordingly, Luke et al. is not prior art against such subject matter. The remainder of Luke et al. that could be prior art against claims 15 and 17 is not sufficient to establish a prima facie case of obviousness, and therefore the present rejection of claims 15 and 17 under 35 USC § 103(a) cannot be sustained.

In addition, the entirety of Luke et al. is disqualified under 35 USC § 103(c)(1) as prior art against the subject application.

1. Luke et al. is Subject Matter Developed By Another Person.

The inventors listed in Luke et al. and the subject application overlap only with respect to Karen Luke, Russell M. Fitzgerald, Keith A. Rispler and Glen C. Fyten. The remaining inventors named in each are different, and therefore Luke et al. constitutes subject matter developed by another person with respect to claims 15 and 17.

2. Luke et al. would Qualify as Prior Art only under 35 USC § 102(e).

The respective filing and publication dates of Luke et al. and the subject application are as follows:

Date	Activity
October 15, 2003	Luke et al. filed
April 1, 2004	Subject Application filed
June 17, 2004	Luke et al. published
December 9, 2004	Subject Application published
November 15, 2005	Luke et al. issued

Luke et al. was not published before the filing date of the subject application, and therefore is not prior art under 35 USC § 102(a) or § 102(b). Further, none of 35 USC §§ 102(c), (d), (f) or (g) are applicable to the subject application. The only remaining category of prior art is defined by 35 USC § 102(e).

As discussed above, Luke et al. was published, is a patent application “by another”, and was filed in the United States before the constructive invention date by the applicant for patent, namely, the date the subject application was filed.

In view of the foregoing, Applicants submit that Luke et al. would qualify as prior art against the subject application only under 35 USC § 102(e).

3. Luke et al. and the Claimed Invention Were, At the Time the Claimed Invention was Made, Owned by the Same Person, or Subject to an Obligation to Assign to the Same Person.

Enclosed is a signed statement from Mr. Craig Roddy of Halliburton Energy Services, Inc., which states that Luke et al. and the subject matter of claims 15 and 17 were, at the time the subject matter of claims 15 and 17 was made, owned by the same person or subject to an obligation of assignment to the same person, namely, to Halliburton Energy Services, Inc.

In view of the foregoing, Applicants submit that all of the requirements of 35 USC §103(c)(1) have been met, and therefore Luke et al. is not available as prior art against the subject application pursuant to 35 USC §103(c)(1).

In view of the foregoing, Applicants respectfully request that the rejection of claims 15 and 17 under 35 USC § 103(a) over Morgan et al. and further in view of Luke et al. be withdrawn.

G. Rejection of Claims 1 – 31 under 35 USC § 103(a)

Claims 1 – 31 stand rejected under 35 USC § 103(a) as being unpatentable over Luke et al. in view of U.S. Patent No. 4,784,693 to Kirkland et al. (“Kirkland et al.”). This rejection is respectfully traversed.

As discussed above with respect to the rejection of claims 15 and 17 under 35 USC § 103(a) over Morgan et al. and Luke et al., Luke et al. is not available as prior art against the claimed subject matter. Thus, to sustain the present rejection, Kirkland et al. alone must be able to support a prima facie case of obviousness.

Standing alone, however, Kirkland et al. does not disclose all of the elements of any of claims 1 – 31. Thus, Kirkland et al. cannot satisfy the third element of a prima facie case of obviousness, and therefore the entire case must fail.

Moreover, Kirkland et al. provides no motivation or suggestion for modifying the methods described therein to include use of a cementing composition that includes zeolite in an amount of at least 20 weight percent, at least one cementitious material, and proportioned fluid loss additives as required by claims 1 – 31. Accordingly, there could be no reasonable

expectation of success for achieving the methods described by claims 1 – 31 by modifying the methods described by Kirkland et al. Thus, Kirkland et al. cannot satisfy even one of the elements of a prima facie case of obviousness of any of claims 1 – 31.

In view of the foregoing, Applicants respectfully request that the rejection of claims 1 – 31 under 35 USC § 103(a) over Luke et al. in view of Kirkland et al. be withdrawn.

H. Rejection of Claims 1 – 3 and 6 – 31 under 35 USC § 103(a)

Claims 1 – 3 and 6 – 31 stand rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 6,457,524 to Roddy (“Roddy”) in view of Kirkland et al. This rejection is respectfully traversed.

As presented herein, claim 1 is drawn to a method of cementing in a subterranean zone that includes forming a cement composition by mixing a cement mix comprising a base blend and proportioned fluid loss additives with a mixing fluid, placing the cement composition into the subterranean zone, and allowing the cement composition to set therein. The base blend required to form the cement composition comprises zeolite in an amount of at least 20 weight percent and at least one cementitious material. The proportioned fluid loss additives include a first fluid loss additive having a first molecular weight and a second fluid loss additive having a second molecular weight, which second molecular weight is less than the first molecular weight. Finally, the first fluid loss additive is present in an amount that is less than the amount of the second fluid loss additive.

Each of claims 2, 3 and 6 – 31 depends directly or indirectly from claim 1, and therefore each includes at least the foregoing elements.

To sustain the present rejection of claims 1 – 3 and 6 – 31 under 35 USC § 103(a), a prima facie case of obviousness must be established. MPEP § 2142 provides that a prima facie case of obviousness requires three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. In the present case, none of the criteria set forth in MPEP § 2142 have been satisfied with respect to claims 1 – 3 and 6 – 31.

Roddy discloses cement compositions and methods for their use. Exemplary cement compositions disclosed by Roddy include a flow enhancing additive that is a particulate solid material having a flow inducing polar chemical absorbed thereon. The particulate solid material can be zeolite, in which case the zeolite carries the flow inducing polar chemical. (Col. 4, lines 36 – 43). The ratio of the zeolite to the polar chemical absorbed thereon is from about 90:10 to about 10:90. (Col. 4, line 58). The additive is blended with cementitious material in an amount of from about 0.01% to about 1.0% by weight of the cementitious material. (Col. 4, lines 60-61). Thus, a cement composition that includes the additive described in Roddy '524 will include zeolite in an amount of less than 1.0% by weight of the cementitious material. To the extent that the cementitious material can be considered to be the base blend of the cement composition described in Roddy '524, and to the extent that the amount of zeolite could be calculated as a percentage of the total weight of the base blend, then the amount of zeolite, expressed as a weight percent of the base blend, would be even less.

Kirkland et al. disclose a cementing composition that includes a hydraulic cement and a water-soluble, non-ionic hydrophobically modified hydroxyethyl cellulose, and may also include a water-soluble, nonionic hydroxyethyl cellulose. (col. 2, lines 28 – 34).

Neither Roddy nor Kirkland et al. discloses, suggests or motivates a method for cementing in a subterranean zone that includes using a cementing composition comprising zeolite and proportioned fluid loss additives such as described in claims 1 – 3 and 6 – 31. For example, Roddy describes using a minimal amount of zeolite in a cementing composition, which minimal amount is far less than that recited in claims 1 – 3 and 6 – 31. Kirkland et al. does not describe using zeolite in a cementing composition at all. Thus, neither Roddy nor Kirkland et al., either alone or in combination, discloses, suggests or motivates all of the elements of each of claims 1 – 3 and 6 – 31. As at least one of the elements of a prima facie case of obviousness has not been satisfied, the entire case must fail.

Roddy and Kirkland et al. also fail to satisfy the remaining elements of the prima facie case. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references to arrive at the subject matter of claims 1 – 3 and 6 – 31. Further, even if such modification were possible, there could be no reasonable expectation of success that the result would be the subject matter of claims 1 – 3 and 6 – 31.

In view of the foregoing, Applicants submit that a prima facie case of obviousness over Roddy in view of Kirkland et al. has not and cannot be established with respect to claims 1 – 3 and 6 – 31. Accordingly, Applicants respectfully request that the rejection of claims 1 – 3 and 6 – 31 under 35 USC § 103(a) over Roddy and Kirkland et al. be withdrawn.

I. New claims 96 – 126

New claims 96 and 110 presented herein are independent. Each of claims 96 and 110 are drawn to a method of cementing in a subterranean zone that includes placing a cement composition into a subterranean zone, and allowing the cement composition to set therein. The cement composition comprises a base blend, proportioned fluid loss additives, and a mixing fluid. The base blend includes zeolite in an amount of at least about 20 weight percent weight percent, and cementitious material. The proportioned fluid loss additives include a first fluid loss additive having a first molecular weight and a second fluid loss additive having a second molecular weight, which second molecular weight is less than the first molecular weight.

According to the method described by claim 96, the second fluid loss additive is present in an amount that is at least about three times greater than the amount of the first fluid loss additive.

According to the method described by claim 110, the second fluid loss additive is present in an amount that is greater than the amount of the first fluid loss additive.

Each of new claims 97 – 109 presented herein depends directly or indirectly from claim 1, and therefore each includes all of the limitations of claim 1. Each of new claims 111 – 126 presented herein depends directly or indirectly from claim 110, and therefore each includes all of the limitations of claim 110.

Applicants submit that claims 96 – 126 are allowable over the art of record for at least the same reasons that apply to claims 1 – 31. Accordingly, Applicants respectfully request favorable consideration of claims 96 – 126.


Conclusion

Claims 1 – 31 and 96 – 126 are now pending in the present application. In view of the foregoing remarks, allowance of claims 1 – 31 and 96 – 126 is respectfully requested. The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of

the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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